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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE collection of information upless it displays a valid OMB control number. Under the Paperw **Application Number** 10/625,626 TRANSMITTAL Filing Date July 24, 2003 First Named Inventor **FORM** Stpehen P. Adams Art Unit **Examiner Name** Janet L. Coppins (to be used for all correspondence after initial filing) Attorney Docket Number 14937,0003 D2 Total Number of Pages in This Submission **ENCLOSURES** (Check all that apply) After Allowance Communication to TC Fee Transmittal Form Drawing(s) Appeal Communication to Board Licensing-related Papers Fee Attached of Appeals and Interferences Appeal Communication to TC ~ Petition (Appeal Notice, Brief, Reply Brief) Amendment/Reply Petition to Convert to a **Proprietary Information** After Final **Provisional Application** Power of Attorney, Revocation Status Letter Change of Correspondence Address Affidavits/declaration(s) Other Enclosure(s) (please Identify Terminal Disclaimer below): **Extension of Time Request** Return Receipt Postcard (1) Request for Refund **Express Abandonment Request** CD, Number of CD(s) Information Disclosure Statement Landscape Table on CD Certified Copy of Priority Remarks Document(s) Reply to Missing Parts/ Incomplete Application Reply to Missing Parts under 37 CFR 1.52 or 1.53 SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT Firm Name Signature Printed name Harold H. Fox Date Reg. No. March 10, 2005 41,498 CERTIFICATE OF TRANSMISSION/MAILING I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below: Signature

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Date

Attorney Docket No.: 14937.0003 D2

HE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/625,626 Art unit : 1625

Applicant : Steven P. Adams et al. Examiner : Janet L. Coppins

Filing date : July 24, 2003

Title : CELL ADHESION INHIBITORS

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REPLY TO OFFICE ACTION MAILED JANUARY 13, 2005

In response to the Office Action mailed January 13, 2005 ("Office Action"), Applicants submit the following remarks.

REMARKS

Applicants thank the Examiner for indicating that claims 1-7, 10 and 11 are allowable. Claims 12-15 stand rejected.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 12-15 have been rejected by the Examiner under 35 U.S.C. § 112, first paragraph, for lack of enablement. Claim 12 is independent, and claims 13-15 depend from it.

The Examiner contends that claims 12-15 are not supported by a specific asserted utility or a well established utility that would enable one skilled in the art to know how to use the claimed invention. See the Office Action at page 2. Specifically, the Examiner contends that because "claim 12 is not directed to a method of treating a disease," the Applicants have failed to set forth a definable utility. See the Office Action at page 2.

Independent claim 12 is directed to a method of preventing, inhibiting or suppressing <u>cell</u> <u>adhesion</u> in a mammal <u>in need thereof</u>. To satisfy enablement under 35 U.S.C. § 112, "All that is necessary is that one skilled in the art be able to practice the *claimed* invention, given the level of knowledge and skill in the art." (emphasis added) MPEP 2164.08; *see e.g. In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). At the time of filing, one of ordinary skill in the art would have been apprised of the disclosed article, Lobb, R.R. and Hemler, M.E., "The Pathophysiologic Role of α4 Integrins In Vivo," *J. Clin. Invest.*, 94, pp. 1722-29 (1994) ("Lobb"), which indicates that "rapidly accumulating in vivo data... suggest that α4 integrin-